



GAP0001-US

PATENT

AF
JRW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: NECMETTIN CAN ET AL. Serial No.: 09/944,383 Filed: SEPTEMBER 4, 2001 For: SYSTEM AND METHOD FOR USING RADIO FREQUENCY IDENTIFICATION IN RETAIL OPERATIONS	Art Unit: 3627 Examiner: CUFF, MICHAEL A.
--	--

TRANSMITTAL OF APPEAL BRIEF

Mail Stop: **Appeal Brief - Patents**
Director of The U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on January 5, 2007.

The Commissioner is hereby authorized to charge the filing fee of \$500 to Deposit Account No. 50-2613. A duplicate copy of this communication is attached for that purpose. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Applicants' representative's Deposit Account No. 50-2613.

Serial No.: 09/944,383
Art Unit: 3627
Inventor: Necmettin CAN et al.


Attorney's Docket No.: GAP0001-US
Page 2

PAUL, HASTINGS, JANOFSKY & WALKER
875 15th Street, N.W.
Washington, D.C. 20005
Tel: 202/551-1847

Respectfully submitted,

NECMETTIN CAN ET AL.

Date: MARCH 2, 2007

By: 
Michael Bednarek
Registration No. 32,329

Attachment: Appeal Brief in triplicate

Customer No. 36183

MB/LDE/ggb

GAP0001-US



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND
INTERFERENCES**

In re the Application of:

NECMETTIN CAN ET AL.

Serial No.: 09/944,383

Filed: SEPTEMBER 4, 2001

For: SYSTEM AND METHOD FOR
USING RADIO FREQUENCY
IDENTIFICATION IN RETAIL
OPERATIONS

Art Unit: 3627

Examiner: CUFF, MICHAEL A.

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provisions of 35 U.S.C. §134 and 37 C.F.R. §41.37, Appellants submit this Appeal Brief to appeal the Examiner's final rejection of claims 35-37, 48, and 51 in the Office Action mailed July 6, 2006.

03/05/2007 MAHME1 00000140 502613 09944383
01 FC:1402 500.00 DA

TABLE OF CONTENTS



Page

I.	37 C.F.R. § 41.37(c)(i) - Real Party In Interest	1
II.	37 C.F.R. § 41.37(c)(ii) - Related Appeals And Interferences	1
III.	37 C.F.R. § 41.37(c)(iii) - Status Of Claims.....	1
IV.	37 C.F.R. § 41.37(c)(iv) - Status Of Amendments	1
V.	37 C.F.R. § 41.37(c)(v) – Summary Of Claimed Subject Matter.....	1
VI.	37 C.F.R. § 41.37(c)(vi) – Grounds Of Rejection To Be Reviewed On Appeal	6
VII.	37 C.F.R. § 41.37(c)(vii) – Argument	6
A.	The Step Of “Subtracting” In Claims 35 And 37 Is Fully Supported By The Written Description In Compliance With 35 U.S.C. § 112, ¶ 1	6
B.	Rejections Under 35 U.S.C. § 103(a)	10
1.	The Examiner’s § 103 Rejection Of Claims 35, 37, and 51 Fails To Put Forth A Prima Facie Case.....	10
2.	The Examiner’s § 103 Rejection Of Claims 35, 36, 37, 48, and 51 Based On Three Cobbled-Together References Lacks Proper Motivation To Combine.....	12
3.	Correlating Fitting Room Data And Sales Data As Recited In Claims 35, 37, And 51 Distinguishes Over The Prior Art.....	15
4.	Correlating Fitting Room Data, Sales Data, And Merchandising Location Data as Recited Claims 35, 36, 37, 48, And 51 Distinguishes Over The Prior Art	17
VIII.	Conclusion	19
IX.	Appendices.....	20
A.	37 C.F.R. § 41.37(c)(viii) - Claims appendix	20
B.	37 C.F.R. § 41.37(c)(ix) – Evidence appendix	24
C.	37 C.F.R. § 41.37(c)(x) – Related proceedings appendix.....	25



I. 37 C.F.R. § 41.37(c)(i) - Real Party In Interest

The real party in interest for this Appeal and the present application is GAP, Inc. of One Harrison Street, San Francisco, California 94105, by way of an Assignment recorded in the U.S. Patent Trademark Office at Reel/Frame 012368/0469.

II. 37 C.F.R. § 41.37(c)(ii) - Related Appeals And Interferences

Appellants, the Appellants' representatives, and the Assignee are not aware of any other pending appeals or interferences that will directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal. Accordingly, as indicated in the Related Proceedings Appendix attached as Appendix C, there are no decisions rendered by a court or the Board in a related proceeding.

III. 37 C.F.R. § 41.37(c)(iii) - Status Of Claims

Claims 35-37, 48, and 51 are pending in the present application. Claims 35-37, 48, and 51 stand rejected under 35 U.S.C. §112, first paragraph and/or under 35 U.S.C. § 103, and are on appeal. The claims on appeal are set forth in the Claims Appendix attached as Appendix A. Claims 35, 36, 37, and 51 are independent. Claim 48 depends from independent claim 36.

IV. 37 C.F.R. § 41.37(c)(iv) - Status Of Amendments

No claim amendments were filed in response to the final Office Action mailed July 6, 2006 and all amendments are believed to have been entered in the present application. Thus, the status of the claims is as set forth in the Claims Appendix attached as Appendix A.

V. 37 C.F.R. § 41.37(c)(v) – Summary Of Claimed Subject Matter

The present invention provides a method for tracking merchandise in a retail setting, and in particular, for compiling data on garments that are taken to a fitting room of the retail store, including the frequency with which purchased and non-purchased garments are tried on, the style

information of the garments, and the merchandising location of the garments. The recited method provides a retailer with unit level visibility within the store environment, enabling a better understanding of successful and unsuccessful garment styles and merchandising techniques, and allowing the retailer to provide increased levels of customer service. (See, e.g., ¶¶ [0028], [0030], and [0083] of the specification.) Indeed, the method provides a retailer with a store-specific in-house market research tool that tracks fitting room data, sales data, and merchandising location data, and provides that data to the retailer for purposes of identifying problematic garments and developing merchandising locations that best promote customer interest and sales.

Claims 35, 36, 37, and 51 are described below, referring to the specification, drawings, and reference numerals. This description is intended to facilitate an understanding of the claims by the Board members and is not intended as a comprehensive claim construction, such as used in the context of an argument of invalidity or infringement. Any reference to more than one reference number or character for any particular claimed element or limitation is illustrative only and is not to be construed as an admission that the claims are limited to any, or all, of the particularly disclosed embodiments.

Claim 35 recites a method for tracking consumer interest in merchandising locations in a retail store, the method comprising:

- associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store (¶ [0010], lines 1-5; ¶ [0046], lines 7-9; and ¶ [0047], lines 4-7);
- associating each RFID tag with style information of its associated garment (¶ [0072], lines 5-9; ¶ [0080], lines 6-7; and ¶ [0083], lines 4-6);

scanning the RFID tagged garments to determine their merchandising locations on a sales floor of the retail store (¶ [0028], lines 5-10; ¶ [0079], lines 1-11; ¶ [0083], lines 13-15; and Figure 6);

scanning the RFID tagged garments that are taken to a fitting room of the retail store by a plurality of customers (¶ [0028], lines 1-3; ¶ [0083], lines 2-4; and original claim 26);

scanning the RFID tagged garments that are purchased after being taken to the fitting room (¶ [0022], lines 5-6; ¶ [0024], lines 3-4; ¶ [0075], lines 1-8; and ¶ [0083], lines 6-11);

subtracting the RFID tagged garments that are purchased after being taken to the fitting room from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased RFID tagged garments (¶ [0028], lines 2-8; ¶ [0083], lines 8-13; and original claim 27); and

displaying, for a tried-on-but-not-purchased RFID tagged garment, the frequency with which the tried-on-but-not purchased RFID tagged garment is tried on (¶ [0028], lines 7-10 and ¶ [0083], lines 11-15), style information of the tried-on-but-not-purchased RFID tagged garment (¶ [0083], lines 6 and 11-13), and the merchandising location of the tried-on-but-not-purchased RFID tagged garment (¶ [0028], lines 6 and 9-10 and ¶ [0083], line 15).

Claim 36 recites a method for tracking consumer interest in merchandising locations within a retail store comprising:

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store (¶ [0010], lines 1-5; ¶ [0046], lines 7-9; and ¶ [0047], lines 4-7);

scanning the RFID tagged garments to determine their merchandising locations on a sales floor of the retail store (¶ [0028], lines 5-10; ¶ [0079], lines 1-11; ¶ [0083], lines 13-15; and Figure 6);

scanning the RFID tagged garments that are taken to a fitting room of the retail store (¶ [0028], lines 1-3; ¶ [0083], lines 2-4; and original claim 26);

correlating the RFID tagged garments that are taken to a fitting room of the retail store with their merchandising locations (¶ [0028], lines 1-6 and ¶ [0083], lines 6-16); and

displaying, based on the correlation, the frequency with which an RFID tagged garment is tried on (¶ [0028], lines 7-10 and ¶ [0083], lines 11-15) and the RFID tagged garment's merchandising location (¶ [0028], lines 6 and 9-10 and ¶ [0083], line 15).

Claim 37 recites a method for tracking consumer interest in merchandising locations in a retail store, the method comprising:

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store (¶ [0010], lines 1-5; ¶ [0046], lines 7-9; and ¶ [0047], lines 4-7);

associating each RFID tag with style information of its associated garment (¶ [0072], lines 5-9; ¶ [0080], lines 6-7; and ¶ [0083], lines 4-6);

scanning the RFID tagged garments to determine their merchandising locations on a sales floor of the retail store (¶ [0028], lines 5-10; ¶ [0079], lines 1-11; ¶ [0083], lines 13-15; and Figure 6);

scanning the RFID tagged garments that are taken to a fitting room of the retail store by a plurality of customers (¶ [0028], lines 1-3; ¶ [0083], lines 2-4; and original claim 26);

scanning, from among the RFID tagged garments that are taken to the fitting room, the RFID tagged garments that are purchased (¶ [0022], lines 5-6; ¶ [0024], lines 3-4; ¶ [0075], lines 1-8; and ¶ [0083], lines 6-11);

subtracting the RFID tagged garments that are purchased from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased

RFID tagged garments (¶ [0028], lines 2-8; ¶ [0083], lines 8-13; and original claim 27); and

displaying, for the tried-on-but-not-purchased RFID tagged garments, the frequency with which the tried-on-but-not purchased RFID tagged garments are tried on (¶ [0028], lines 7-10 and ¶ [0083], lines 11-15), style information of the tried-on-but-not-purchased RFID tagged garments (¶ [0083], lines 6 and 11-13), and the merchandising locations of the tried-on-but-not-purchased RFID tagged garments (¶ [0028], lines 6 and 9-10 and ¶ [0083], line 15).

Claim 51 recites a method for tracking consumer interest in merchandising locations in a retail store comprising:

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store (¶ [0010], lines 1-5; ¶ [0046], lines 7-9; and ¶ [0047], lines 4-7);

associating each RFID tag with style information of its associated garment (¶ [0072], lines 5-9; ¶ [0080], lines 6-7; and ¶ [0083], lines 4-6);

scanning the RFID tagged garments to determine their merchandising locations in the retail store before the RFID tagged garments are taken to a fitting room (¶ [0028], lines 5-10; ¶ [0079], lines 1-11; ¶ [0083], lines 13-15; and Figure 6);

scanning RFID tagged garments that are taken to the fitting room of the retail store by a plurality of customers to determine tried-on RFID tagged garments (¶ [0028], lines 1-3; ¶ [0083], lines 2-4; and original claim 26);

correlating the tried-on RFID tagged garments to sales data to determine tried-on-but-not-purchased RFID tagged garments (¶ [0028], lines 2-8 and ¶ [0083], lines 8-13); and

displaying, for the tried-on-but-not-purchased RFID tagged garments, the frequency with which the tried-on-but-not purchased RFID tagged garments are tried on (¶ [0028], lines 7-10 and ¶ [0083], lines 11-15), style information of the tried-on-but-not-purchased RFID tagged garments (¶ [0083], lines 6 and 11-13), and the

merchandising locations of the tried-on-but-not-purchased RFID tagged garments (¶ [0028], lines 6 and 9-10 and ¶ [0083], line 15).

VI. 37 C.F.R. § 41.37(c)(vi) – Grounds Of Rejection To Be Reviewed On Appeal

The July 6, 2006 Office Action rejected claims 35 and 37 under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement. Claims 35, 36, 37, 48, and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,313,745 to Suzuki (“Suzuki”) in view of U.S. Patent No. 6,127,928 to Issacman (“Issacman”) and U.S. Patent No. 5,572,653 to DeTemple et al. (“DeTemple”).

The statement of issues is therefore as follows:

(1) Whether claims 35 and 37 comply with the written description requirement under 35 U.S.C. § 112, ¶ 1; and

(2) Whether claims 35, 36, 37, 48, and 51 are patentable over Suzuki in view of Issacman and DeTemple.

VII. 37 C.F.R. § 41.37(c)(vii) – Argument

A. The Step Of “Subtracting” In Claims 35 And 37 Is Fully Supported By The Written Description In Compliance With 35 U.S.C. § 112, ¶ 1

The Examiner rejected claims 35 and 37 under 35 U.S.C. § 112, ¶ 1, for reciting the step of “subtracting.” The Examiner asserted that this subtraction step is not disclosed in the specification and disagreed with the Applicants’ citation of support in the specification. The Applicants cited support for the recitation in the specification at, for example, ¶ [0028], lines 2-8. (Amendment, April 19, 2006, page 11, lines 2-6.) Applicants respectfully submit that this passage, when comprehended within the context of the remaining teachings of Applicants’ disclosure and the knowledge of one skilled in the art, fully supports the step of “subtracting.”

Indeed, as anyone would recognize, the step of subtracting is merely a different way of reciting the step of determining the difference between two things or comparing two things.

Regarding the particular limitations in question, claims 35 and 37 recite the following similar language:

Claim 35:

“subtracting the RFID tagged garments that are purchased after being taken to the fitting room from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased RFID tagged garments;”

Claim 37

“subtracting the RFID tagged garments that are purchased from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased RFID tagged garments;”

As a preliminary matter, Applicants respectfully submit that the Examiner has failed his initial burden of establishing a *prima facie* case of unpatentability based on noncompliance with the written description requirement. “That burden is discharged by ‘presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.’” *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996). “If, on the other hand, the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Id.*

Here, Applicants set forth a detailed citation and explanation of support for the recited “subtraction.” Specifically, Applicants explained that ¶ [0028] of the specification “describes the reading of RFID tagged garments brought into the fitting room (lines 2-3), the correlating of that fitting room data with sales (*i.e.*, purchases) data (lines 5-6), and the identification of products tried on but not purchased (lines 7-8).” (April 19, 2006 Amendment, page 11, lines 3-6.) Yet,

after acknowledging the Applicants' cited support, the Examiner simply stated his rejection in two perfunctory sentences: "The examiner does not concur. The specification does not disclose subtraction." (July 6, 2006 Office Action, page 2.) Therefore, in providing no evidence or reasoning, the Examiner has failed to present a *prima facie* case under 35 U.S.C. § 112, ¶ 1.

Setting aside the deficient rejection, a review of the written description from the standpoint of the skilled artisan shows that the recited subtraction steps are adequately supported. As stated in M.P.E.P. § 2163.I.B, the fundamental factual inquiry in determining compliance of new or amended claims with the written description requirement is "whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." *Vas Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) ("[T]he test for sufficiency of support ... is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'") (quoting *Ralston Purina Co. v. Far Mar Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985)).

Claims 35 and 37 recite subtracting the RFID tagged garments that are purchased from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased RFID tagged garments. The result of this step is the determination of RFID tagged garments that have been tried on in the fitting room but not purchased. The specification clearly discloses this determination. For example, lines 7-8 of ¶ [0028] describe correlating fitting room data with sales data and "identifying products that are frequently tried on, but seldom purchased." In even more detail, lines 4-13 of ¶ [0083] describe gathering "information as to what products are taken to fitting rooms" (lines 4-5), correlating sales data to the fitting room data "to provide invaluable insight as to which of the products that are tried by consumers are ultimately purchased" (lines 6-

8), and using the data to “show that a particular style of garment is frequently tried on, but seldom purchased” (lines 11-13).

These descriptions therefore explicitly disclose gathering data on RFID tagged garments that are taken to the fitting room (*i.e.*, “fitting room data”), gathering data on RFID tagged garments that are purchased (*i.e.*, “sales data”), and determining tried-on-but-not-purchased RFID tagged garments (*i.e.*, “tried on, but seldom purchased”). The determination of the “tried on, but seldom purchased” garments is a direct result of the correlation of fitting room data to sales data. And, it would be clear to those skilled in the art that such correlation would involve comparing the two data sets or, in other words, subtracting one data set (the purchased garments) from the initial data set (the tried-on garments) to yield the tried-on-but-not-purchased garments.

In fact, the Examiner’s own treatment of the previous version of claim 35 indicates that the steps of *comparing* purchased garments to tried-on garments and *determining*, from the comparison, tried-on-but-not-purchased garments, are adequately supported by the written description. As set forth in Applicants’ July 7, 2005 Amendment, the previous version of claim 35 read in pertinent part as follows:

“comparing the RFID tagged garments that are purchased after being taken to the fitting room to the RFID tagged garments that are taken to the fitting room;
determining, from the comparison, RFID tagged garments that are tried on but not purchased;”

In the subsequent October 19, 2005 Office Action, the Examiner did not reject these comparing and determining steps under § 112, ¶ 1, apparently recognizing correctly that such steps are fully supported by the written description. By the same token, as an alternate expression of these steps that would be clear to any skilled artisan, the step of subtracting is also fully supported by the written description.

Notwithstanding Applicants' arguments above showing that the step of subtracting is fully supported by the originally-filed specification, Applicants further submit that, based on common dictionary definitions, the term "subtracting" is logically derived from the specification's discussions of "correlating" (fitting room and sales data) and "identifying" (tried on, but seldom purchased garments). The WordNet online dictionary (<http://wordnet.princeton.edu/>) defines the verb "correlate" as follows: "bring into a mutual, complementary, or reciprocal relation." See Appendix B attached hereto. Thus, in this case, the fitting room data and sales data are brought into a mutual relation, and compared to each other to identify differences. These differences are determined by subtracting the sales data from the fitting room data. Thus, the ordinary dictionary definition further shows that "subtracting" is adequately supported by the written description.

Thus, Applicants respectfully submit that the present application, as originally filed, contained a sufficient description of the "subtracting" steps.

B. Rejections Under 35 U.S.C. § 103(a)

1. The Examiner's § 103 Rejection Of Claims 35, 37, and 51 Fails To Put Forth A *Prima Facie* Case

The Examiner has failed to set forth an appropriate *prima facie* case to support the § 103 rejection of claims 35, 37 and 51 because the July 6, 2006 Office Action does not demonstrate that each of the claimed features is present or even suggested by the prior art of record. In particular, the Office Action does not address the "subtraction" feature set forth in the claims, which specifically recites subtracting purchased garments from tried on garments to yield tried-on-but-not-purchased garments. The Office Action at page 4 asserts that Figure 9 of Suzuki shows "a trial history including tried and purchased or not purchased data (correlation)" and that "Suzuki shows a relationship in as much as applicant does." However, these alleged teachings of

Suzuki do not relate to the recited “subtraction” step of claims 35, 37, and 51 and instead relate to the claimed step of displaying, for a tried-on-but-not-purchased RFID tagged garment, the frequency with which the tried-on-but-not purchased RFID tagged garment is tried on, style information of the tried-on-but-not-purchased RFID tagged garment, and the merchandising location of the tried-on-but-not-purchased RFID tagged garment. Indeed, because Suzuki is focused on providing service to a single customer, rather than the present invention’s analysis of garment styles and merchandising locations, Suzuki has no need to correlate fitting room data to sales data in this manner, and indeed, does not teach or suggest as such.

The Examiner’s citation of Issacman and DeTemple fails to cure this deficiency. The Examiner cited Issacman merely for teaching the tracking of objects to provide location information, which bears no relevance to the subtraction feature. The Examiner cited DeTemple for teaching a retail facility display system that can correlate products with their store location, yet these teachings fail to address correlations of fitting room data and sales data to determine tried-on-but-not-purchased garments. In sum, nowhere does the Examiner specifically point out where the prior art discloses the claimed subtraction feature.

The July 6, 2006 Office Action therefore fails to demonstrate that the prior art discloses the claimed subtraction feature. For this reason, the rejection of claims 35, 37, and 51 is legally deficient and should be reversed.

2. The Examiner's § 103 Rejection Of Claims 35, 36, 37, 48, and 51 Based On Three Cobbled-Together References Lacks Proper Motivation To Combine

In rejecting claims under 35 U.S.C. § 103(a), several basic factual inquiries must be made to determine obviousness or non-obviousness of patent application claims under 35 U.S.C. § 103. These factual inquiries are set forth in *Graham v. John Deere Co.*, 383 US 1, 17, 148 USPQ 459, 467 (1966);

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined.

As stated by the Federal Court in *In re Ochiai*, 37 USPQ 2d 1127, 1131 (Fed. Cir. 1995);

[T]he test of obviousness *vel non* is statutory. It requires that one compare the claim's subject matter as a whole with the prior art to which the subject matter pertains. 35 U.S.C. § 103. The inquiry is thus highly fact-specific by design . . . When the references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (Emphasis added.)

In rejecting claims under 35 U.S.C. § 103(a), an Examiner bears an initial burden of presenting a *prima facie* case of obviousness. A *prima facie* case of obviousness is established only if there is a suggestion or motivation to combine reference teachings; a reasonable expectation of success; and the prior art references, when combined, teach or suggest all the claim limitations. If an Examiner fails to establish a *prima facie* case, a rejection is improper and will be overturned. (*In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993) ("If examination . . . does not produce a *prima facie* case of unpatentability, then without more, the

Applicant is entitled to the grant of the patent.”); *In re Oetiker*, 977 F.2d 1443, 1445-1446, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)).

The requisite standard for motivation to combine references requires a showing that one of ordinary skill in the art would have been motivated to combine the references, not that they may have combined the references. Under M.P.E.P. § 2143, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the July 6, 2006 Office Action, the Examiner correctly noted that Suzuki fails to teach or suggest both the use of RFID tags to determine the locations of garments on a sales floor and also the correlating of garments taken into the fitting room with their merchandising location. The Examiner then looked to Issacman and DeTemple to provide such teachings. With both of these secondary references, however, the Examiner failed to cite proper motivation.

For the garment location feature, the Examiner modified Suzuki to include Issacman’s RFID tracking system that locates and tracks objects throughout a facility and cited as motivation the desire to “be able to use the object’s location information.” (July 6, 2006 Office Action, page 4, lines 7-10.) Such reasoning is circular and without merit. The simple fact that information is

“able” to be used does not amount to proper motivation. And, in this case, Suzuki actually discounts any desire for location information by instead emphasizing the need to gather data necessary for recommending garment styles to a particular customer. (Column 1, lines 8-10 and column 2, lines 10-23.) Thus, the vague notion of “using” a garment’s location information fails to provide proper motivation. Nothing the Examiner has cited – neither Suzuki, nor Issacman, nor the prior art as a whole – suggests the *desirability* of making the asserted combination. *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004).

In addition, because Suzuki does not disclose using RFID tags to determine the merchandising locations of garments on a sales floor, Suzuki fails to teach or suggest any aspect of merchandising location as it relates to consumer interest. Thus, there would be no suggestion or motivation to even look to Issacman to locate items. Moreover, even if one were to look to Issacman, because Issacman relates to locating items (primarily, files) within a facility, Issacman contains no teaching or suggestion to correlate the RFID tagged garments that are taken to a fitting room of the retail store with their merchandising locations and to display, based on this correlation, the frequency with which a garment is tried on and the garment’s merchandising location, which can indicate consumer interest in merchandising locations within the retail store.

For the feature of correlating tried-on garments to their merchandising locations, the Examiner modified Suzuki to “include the DeTemple data manipulation, including correlating products with their store location, in order to understand customer behavior and increase sales.” (July 6, 2006 Office Action, page 4, lines 17-20.) DeTemple’s teachings, however, are limited to generalized concepts of data manipulation and provide no motivation for correlating fitting room data with merchandising data. The vague motivations of understanding customer behavior and increasing sales, even if suggested by the prior art as a whole, would not lead one of ordinary

skill in the art to the present invention's feature of displaying the frequency with which a garment is tried on along with the merchandising location of the garment. The Examiner's combination of references to provide this correlation between fitting room data and merchandising location is therefore based on improper hindsight reconstruction and clearly extracted from the Applicants' own specification.

Thus, Applicants respectfully submit that the Examiner's § 103 rejection of claims 35, 36, 37, 48, and 51 lacks proper motivation.

3. Correlating Fitting Room Data And Sales Data As Recited In Claims 35, 37, And 51 Distinguishes Over The Prior Art

Even assuming it would have been obvious to combine Suzuki, Issacman, and DeTemple, which Appellants do not concede, such a combination would not have resulted in the invention recited in claims 35, 37, and 51, which each recite aspects of correlating fitting room data to sales data. Specifically, claims 35, 37, and 51 recite scanning RFID tagged garments taken to the fitting room and RFID tagged garments that are purchased after being taken to the fitting room, and subtracting the purchased garments from the fitting room garments to yield tried-on-but-not-purchased garments. This correlation between fitting room data and sales data – as embodied in the subtracting step – is neither taught nor suggested by applied prior art. Moreover, the prior art fails to teach or suggest the tangible result of this correlation, which is recited in the displaying steps of claims 35, 37, and 51 (*i.e.*, for the tried-on-but-not-purchased garments, displaying the frequency by which the garments are tried on, style information, and merchandising location).

In the July 6, 2006 Office Action, the Examiner cited only two aspects of correlating data: (1) a correlation between tried on and purchased items and tried on and not purchased items, as allegedly disclosed in Suzuki (July 6, 2006 Office Action, page 4, lines 1-2); and (2) correlating products with their store location, as allegedly disclosed in DeTemple (July 6, 2006

Office Action, page 4, lines 16-17 and 20-21). These aspects of correlating data, however, fail to teach or suggest the claimed invention's specific manner of correlating fitting room data and sales data by subtraction, based on fitting room data from a plurality of customers.

Suzuki merely displays, from among a group of items tried on by *one customer*, items that were purchased and items that were not purchased, and in no way teaches or suggests the claimed subtraction step from among a plurality of garments taken to a fitting room by a *plurality of customers* (preceding the subtraction step, claims 35, 37, and 51 each recite "scanning the RFID tagged garments that are taken to a fitting room of the retail store by a *plurality of customers*" (emphasis added)). Suzuki is focused on (a) recommending additional garments that are consistent with those that a customer has tried on and match the customer's profile information (*see, e.g.*, column 1, lines 8-10 and column 2, lines 10-23); (b) maintaining a purchase and trial history of the customer, which indicates items that the customer has taken to the fitting room and whether the customer has purchased the items or not (*see, e.g.*, column 2, lines 46-50.); and (c) determining popular items based on the frequency that such items are taken to the fitting room (*see, e.g.*, column 2, line 66 to column 3, line 2.)

Although Suzuki may disclose collecting a trial history of tried on and not purchased data for a *particular customer* and the simple determination of popular items based on the frequency by which such items are taken to the fitting room, Suzuki in no way teaches or suggests a correlation, *among many different customers*, of RFID tagged garments that are tried on and purchased to garments that are tried on, to yield tried-on-but-not-purchased garments, for the purpose of displaying information about those tried-on-but-not-purchased garments (*i.e.*, frequency by which tried on, style information, and merchandising location). Suzuki is primarily concerned with providing efficient customer service to an *individual customer* by recommending

garment styles, colors, brands, etc. consistent with the individual customer's trial history. Suzuki therefore analyzes the customer's preference for particular garment styles, and may determine styles that are not preferred by the individual customer, but notably does not analyze the fitting room data and sales data among many different customers. In this way, Suzuki fails to teach or suggest the correlation of fitting room data and sales data as recited in claims 35, 37, and 51.

DeTemple fails to cure this deficiency. DeTemple teaches a system for communicating between a store computer and locations in the aisles of the store. (Column 4, lines 15-17). One embodiment provides a product information display system that sends information (*e.g.*, price) to display terminals on shelves throughout the store. (Column 4, lines 20-22.) Another embodiment provides an item tracking system that tracks shopping carts throughout the store. (Column 4, lines 22-25.) The data manipulation to which the Examiner referred is only a generalized teaching of the store data, product data, and customer data that can be gathered and sorted using the tracking system. (Column 9, lines 22-46.) Indeed, DeTemple does not even mention a fitting room, let alone a correlation between fitting room data and sales data.

Applicants therefore respectfully submit that claims 35, 37, and 51 are patentable over the cited prior art.

4. Correlating Fitting Room Data, Sales Data, And Merchandising Location Data as Recited Claims 35, 36, 37, 48, And 51 Distinguishes Over The Prior Art

Even assuming it would have been obvious to combine the references, which Appellants do not concede, such a combination would not have resulted in the invention recited in claims 35, 36, 37, 48, and 51, which each recite a correlation between fitting room data and merchandising location. Specifically, claims 35, 36, 37, 48, and 51 recite the displaying of the frequency by which a garment is tried on and the merchandising location of the garment. This displayed correlation can involve garments that are tried-on (as in claim 36), tried-on-and-

purchased (as in claim 48), or tried-on-but-not-purchased (as in claims 35, 37, and 51). These displayed correlations can provide a retailer with insight into problematic garments, *e.g.*, due to fit or detailing. (*See, e.g.*, ¶¶ [0016] and [0083] of the present specification.)

In the July 6, 2006 Office Action, the Examiner cited DeTemple for teaching a correlation between products and their store location. As an initial matter, however, DeTemple at best provides only a vague, generalized teaching of data manipulation, and does not discuss any correlation between consumer interest in a product and the product's merchandising location. In fact, DeTemple teaches away from such correlations by emphasizing the features and advantages of its tracking system, which tracks customer shopping carts and baskets (not individual products). (Column 4, lines 22-25; column 7, lines 55-58; and column 9, lines 11-15 and 30-31.) As DeTemple explains, the data collected from tracking this "shopping traffic" can be manipulated and sorted as a function of product location. Thus, DeTemple teaches that the product location is a variable for the "shopping traffic" analysis, and does not teach or suggest any correlation between consumer interest in a product and the product location.

Moreover, DeTemple provides no teaching or suggestion of fitting room data as a measure of consumer interest. For this element of the claimed invention, the Examiner apparently relied on Suzuki. However, as explained above, where Suzuki discusses tried on and purchased data and tried on and not purchased data, it does so in the context of a single customer. Where Suzuki discusses the popularity of an item, it does so based on the frequency such item is taken to a fitting room and not on any sales data. Thus, even if Suzuki is modified to add the product location aspect of DeTemple, Suzuki still fails to teach or suggest the correlation of fitting room data, sales data, and merchandising location data.

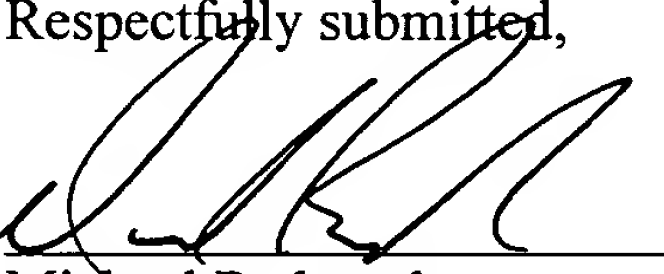
For these reasons, Applicants respectfully submit that claims 35, 36, 37, 48, and 51 are patentable over the cited prior art.

VIII. Conclusion

For at least the reasons discussed above, it is respectfully submitted that: 1) claims 35 and 37 comply with the written description requirement under 35 U.S.C. § 112, ¶ 1; and 2) claims 35, 36, 37, 48, and 51 are patentable over Suzuki in view of Issacman and DeTemple. Appellants respectfully request this Honorable Board to reverse the rejection of these claims and direct that the claims be passed to issue.

PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15th Street, N.W.
Washington, D.C. 20005
Tel: 202-551-1700

Date: March 2, 2007

Respectfully submitted,

By: Michael Bednarek
Registration No. 32,329

MB/SPA
Customer No. 36183

Attachments:
Claims appendix
Evidence appendix
Related proceedings appendix

IX. Appendices

A. 37 C.F.R. § 41.37(c)(viii) - Claims appendix

35. A method for tracking consumer interest in merchandising locations in a retail store, the method comprising:

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store;

associating each RFID tag with style information of its associated garment;

scanning the RFID tagged garments to determine their merchandising locations on a sales floor of the retail store;

scanning the RFID tagged garments that are taken to a fitting room of the retail store by a plurality of customers;

scanning the RFID tagged garments that are purchased after being taken to the fitting room;

subtracting the RFID tagged garments that are purchased after being taken to the fitting room from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased RFID tagged garments; and

displaying, for a tried-on-but-not-purchased RFID tagged garment, the frequency with which the tried-on-but-not purchased RFID tagged garment is tried on, style information of the tried-on-but-not-purchased RFID tagged garment, and the merchandising location of the tried-on-but-not-purchased RFID tagged garment.

36. A method for tracking consumer interest in merchandising locations within a retail store comprising:

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store;

scanning the RFID tagged garments to determine their merchandising locations on a sales floor of the retail store;

scanning the RFID tagged garments that are taken to a fitting room of the retail store;

correlating the RFID tagged garments that are taken to a fitting room of the retail store with their merchandising locations; and

displaying, based on the correlation, the frequency with which an RFID tagged garment is tried on and the RFID tagged garment's merchandising location.

37. (Currently Amended) A method for tracking consumer interest in merchandising locations in a retail store, the method comprising:

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store;

associating each RFID tag with style information of its associated garment;

scanning the RFID tagged garments to determine their merchandising locations on a sales floor of the retail store;

scanning the RFID tagged garments that are taken to a fitting room of the retail store by a plurality of customers;

scanning, from among the RFID tagged garments that are taken to the fitting room, the RFID tagged garments that are purchased;

subtracting the RFID tagged garments that are purchased from the RFID tagged garments that are taken to the fitting room to yield tried-on-but-not-purchased RFID tagged garments; and

displaying, for the tried-on-but-not-purchased RFID tagged garments, the frequency with which the tried-on-but-not purchased RFID tagged garments are tried on, style information of the tried-on-but-not-purchased RFID tagged garments, and the merchandising locations of the tried-on-but-not-purchased RFID tagged garments.

48. The method of claim 36, further comprising:

scanning RFID tagged garments that are taken to the fitting room and subsequently purchased to determine tried-on-and-purchased RFID tagged garments; and

displaying the tried-on-and-purchased RFID tagged garments and merchandising location information of the tried-on-and-purchased RFID tagged garments.

51. A method for tracking consumer interest in merchandising locations in a retail store comprising:

associating a radio frequency identification (RFID) tag with each garment of a plurality of garments in the retail store;

associating each RFID tag with style information of its associated garment;

scanning the RFID tagged garments to determine their merchandising locations in the retail store before the RFID tagged garments are taken to a fitting room;

scanning RFID tagged garments that are taken to the fitting room of the retail store by a plurality of customers to determine tried-on RFID tagged garments;

correlating the tried-on RFID tagged garments to sales data to determine tried-on-but-not-purchased RFID tagged garments; and

displaying, for the tried-on-but-not-purchased RFID tagged garments, the frequency with which the tried-on-but-not purchased RFID tagged garments are tried on, style information of the tried-on-but-not-purchased RFID tagged garments, and the merchandising locations of the tried-on-but-not-purchased RFID tagged garments.

B. 37 C.F.R. § 41.37(c)(ix) – Evidence appendix

The evidence relied upon by the Applicant in this appeal includes the definition appearing on the following page.

C. 37 C.F.R. § 41.37(c)(x) – Related proceedings appendix

None

WordNet Search - 3.0 - [WordNet home page](#) - [Glossary](#) - [Help](#)

Word to search for:

Display Options:

Key: "S:" = Show Synset (semantic) relations, "W:" = Show Word (lexical) relations

Noun

- **S: (n) correlate, correlative** (either of two or more related or complementary variables)

Verb

- **S: (v) correlate** (to bear a reciprocal or mutual relation) *"Do these facts correlate?"*
- **S: (v) correlate** (bring into a mutual, complementary, or reciprocal relation) *"I cannot correlate these two pieces of information"*

Adjective

- **S: (adj) correlative, correlate, correlated** (mutually related)

[WordNet home page](#)